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Attorney Docket No. 54084-2163

SEP 09 2003

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REMARKS:**Objection to Oath/Declaration**

In the Final Rejection of Paper No. 10, the identical arguments presented in Paper No. 6 that the Oath/Declaration of the application was defective were repeated. The arguments presented in Amendment and Response B, as well as the original Oath and Declaration and the Application Data Sheet submitted with Amendment and Response B have been ignored and not addressed in the Final Rejection. It is requested that the Examiner consider the explanation provided in Amendment and Response B as well as the original Oath and Declaration and the Application Data Sheet submitted with Amendment and Response B in order to better prepare the application for Appeal.

In the Office Action of Paper No. 6, the Oath and Declaration was considered to be defective because it did not state that all errors being corrected arose without deceptive intention. However, in referring to page 7, lines 15 and 16 of the Oath and Declaration it can be seen that it actually does state that "[t]he aforementioned errors arose without any deceptive intention on the part of the applicant, the inventors, the assignee of the original patent, or their legal representatives." Thus, for this reason, it is respectfully submitted that the Oath and Declaration is not defective.

The Oath and Declaration was considered to be defective because the original Oath and Declaration was amended on January 17, 2001, correcting the spelling of the name of one inventor and changing the residence address of another inventor.

It is respectfully submitted that these types of amendments made to the Oath and Declaration do not change the Oath and Declaration to the extent that a substitute Oath

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and Declaration is required. MPEP § 602.01 specifically sets forth that a deficiency in the Oath or Declaration can be corrected by a supplemental paper such as an Application Data Sheet and a new Oath or Declaration is not necessary.

An originally executed Oath and Declaration without the correcting amendments made to the Oath and Declaration filed with the application was filed with Amendment and Response B. In addition, an Application Data Sheet correcting the incorrect information on the filed Oath and Declaration, i.e. the misspelled inventors name and the changed inventors address was filed with Amendment and Response B. The original Oath and Declaration and the Application Data Sheet have been totally ignored in the Final Rejection. It is respectfully submitted that the filing of the original Oath and Declaration and the Application Data Sheet with Amendment and Response B eliminates the need for a substitute Oath and Declaration under MPEP §602.01.

It is respectfully submitted that in view of the explanation provided above and in view of the original Oath and Declaration and Application Data Sheet submitted earlier, the Oath and Declaration of the application is not defective.

Claim Rejections Under 35 U.S.C. §251

In the Final Rejection of Paper No. 10, the arguments on the allowability of amended claims 1, 9, 12, and 21 presented in Amendment and Response B were ignored. The Final Rejection of independent claims 1, 9, 12, and 21, and dependent claims 3, 4, 7, 10, 11, 13-15, and 22-25 is basically the same rejection presented in the Office Action of Paper No. 6, except for the addition of new independent claim 26 and new dependent claims 27-33 to the rejected claims. This is made clear by considering that independent claim 26 and dependent claims 27 and 28 recite the identical subject

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matter of the Tano Patent No. 5,921,998, that dependent claim 29 recites the identical subject matter of claim 2 of the Tano patent, that dependent claim 30 recites the identical subject matter of claim 3 of the Tano patent, that dependent claim 31 recites the identical subject matter of claim 4 of the Tano patent, that dependent claim 32 recites the identical subject matter of claim 5 of the Tano patent, and that dependent claim 33 recites the identical subject matter of claim 6 of the Tano patent. If the amendments to the claims and the arguments on patentability presented in Amendment and Response B had been thoroughly considered by the Examiner, the correspondence of the subject matter of claims 26-33 with the subject matter of the claims of the Tano patent would have been noticed and at least some of these claims would have been allowed. It is clear from this that the subject matter of new claims 26-33 was not considered in the Final Rejection, and that these claims were merely added to the previously rejected claims. It is requested that the Examiner consider the arguments on patentability presented in Amendment and Response B, and comment on these arguments in order to better prepare the application for Appeal.

Claims 1, 3-4, 7, 9-15, and 21-33 were rejected under 35 U.S.C. § 251 as being an improper recapture of claimed subject matter surrendered in the application for patent upon which the present reissue application is based.

In the rejection it is contended that claim 1 of the original patent application was amended to recite "a hollow tapered front tip" and "grains are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip" to overcome an anticipation rejection in view of the U.S. Patent of Shimizu No. 3,809,101. It is also contended that an argument was presented that the Shimizu patent does not disclose the two features cited above, and therefore amended claim 1 was defined over Shimizu. The rejection

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states that the omission of the features quoted above from independent claims 1, 9, 12 and 21 of the present application presents an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue application is based.

It is respectfully submitted that the above set forth recount of the prosecution history of the patent upon which the present reissue application is based is not accurate. Claim 1 was amended to recite "a hollow tapered front tip" and "said grains are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip" among other amendments made to the claim. However, the argument distinguishing the Shimizu reference stated that the subject matter claimed was

"clearly distinguished from the nail file filing an individual's nails as shown in Shimizu which neither comprises a hollow tapered front tip of an elastic body nor does the same teach limiting the location of the grains to the range presently claimed and instead teaches only the utilization of an abrasive sheet 9 which extends substantially the entire length of the holding member".

There is no mention of the specific 0.5 mm to 3.0 mm range in the argument distinguishing the Shimizu reference. Thus, there is no evidence in the prosecution history that the specific range of 0.5 mm to 3.0 mm was added to claim 1 to distinguish the subject matter claimed from Shimizu. The only evidence provided by the REMARKS portion of the amendment states that Shimizu neither comprises a hollow tapered front tip nor teaches limiting the location of the grains to a range.

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"Reissued claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule." *In re Clement*, 131 F. 3d. 1464, 1470, 45 U.S.P.Q. 2d 1161, 1165 (Fed. Cir. 1997).

The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable. Seattle Box Co. v. Industrial Crating and Packaging, Inc., 731 F. 2d 818, 826, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).

There is no evidence presented that the limitation of 0.5 mm to 3.0 mm was added to claim 1 of the original patent application to avoid the Shimizu reference. Claim 1 was sufficiently amended to include the limitation of the grains being located in a range from an end portion of the front tip to distinguish the subject matter of the invention from the Shimizu reference. As set forth in the REMARKS, the Shimizu nail file did not teach limiting the location of the grains to the range, but instead teaches only the utilization of an abrasive sheet which extends substantially the entire length of the holding member of the nail file. Thus, it is not necessary that the independent claims of the reissue application include in their limitations the specific 0.5 mm to 3.0 mm range.

Claim 1 of the application includes the limitation of the fine-grains being located in a range from an end portion of the tip. Claim 9 includes the limitation of the fine-grains being located in a range from an end portion of the tip. Claim 12 includes the limitation of the elastic body having a hollow, generally tubular shape, and the fine-grains being located in a range on said distal end portion of the elastic body. Claim 21 includes the limitations of a flexible tapered tip and the fine-grains being fixed to the elastic portion of the tool located in a range from an end portion of the tapered tip.

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It is respectfully submitted that claims 1, 9, 12 and 21 are in conformance with 35 U.S.C. §251 and are allowable.

In the Final Rejection, new independent claim 26 and its dependent claims 27-33 were added to the list of claims rejected under 35 U.S.C. §251. As stated above, the Final Rejection of claims 26-33 basically repeats the rejection of claims 1-7, 9-15, and 21-25 made in the Office Action of Paper No. 6. The rejection of claims 26-33 was not specifically addressed in the Final Rejection.

Claim 26 conforms to the language of claim 1 of the issued Patent No. 5,921,998 except for the word "hollow" in describing the tapered front tip and the words "of 0.5 mm to 3.0 mm" in describing the range of the fine-grains. These features are included in the dependent claims 27 and 28 of claim 26. For the reasons set forth above, it is respectfully submitted that new claims 26-33 are also allowable.

It is respectfully submitted that in view of the remarks presented herein, the application is in condition for allowance and favorable action is requested.

Respectfully submitted,

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